

ESTTA Tracking number: **ESTTA621775**

Filing date: **08/15/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217239
Party	Plaintiff Instagram, LLC
Correspondence Address	Anne H. Peck Cooley LLP 1299 Pennsylvania Avenue, NW, Suite 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com, peckah@cooley.com, afennimore@cooley.com, kkra- jeck@cooley.com, chwang@cooley.com, thadid@cooley.com, cnath- an@cooley.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Rebecca Givner-Forbes
Filer's e-mail	rgivnerforbes@cooley.com, trademarks@cooley.com, bhughes@cooley.com, pwillsey@cooley.com, afennimore@cooley.com, peckah@cooley.com
Signature	/Rebecca Givner-Forbes/
Date	08/15/2014
Attachments	Amended Notice of Opposition.pdf(24581 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 86/036,656
For the Trademark INSTABANG
Published in the Official Gazette on January 7, 2014

INSTAGRAM, LLC,)	
)	
Opposer,)	
)	Opposition No. 91217239
v.)	
)	
GLOBAL PERSONALS, LLC,)	
)	
Applicant.)	
_____)	

AMENDED NOTICE OF OPPOSITION

Opposer Instagram, LLC (“Instagram”), a Delaware limited liability company having its principal place of business at 1601 Willow Rd., Menlo Park, California 94025, believes that it will be damaged by the issuance of a registration for the mark INSTABANG (the “INSTABANG Mark” or “Applicant’s Mark”), as applied for in Application Serial No. 86/036,656 filed on August 13, 2013 by Global Personals, LLC (“Applicant”), a Florida limited liability company with a mailing address of 12388 SW 82nd Ave., Miami, Florida, 33156, and therefore files this Amended Notice of Opposition.

As grounds for opposition, Instagram alleges that:

1. Since the launch of its photo sharing and social networking service and software application in October 2010, Instagram has continuously used the mark INSTAGRAM in interstate commerce in the United States in connection with its goods and services.
2. Instagram owns multiple U.S. registrations and applications for the mark

INSTAGRAM, which cover a variety of goods and services, including, but not limited to:

- Downloadable computer software for modifying the appearance and enabling transmission of photographs;
- Computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information;
- Telecommunications services, namely electronic transmission of data, messages, graphics, images and information;
- Computer services, namely, providing an interactive website featuring technology that allows users to manage their online photograph and social networking accounts;
- Online software for modifying the appearance and enabling transmission of photographs;
- Providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; and,
- Social introduction, networking and dating services.

True and correct copies of its registration certificates and the U.S. Patent and Trademark Office online status pages for Instagram's pending trademark applications for the INSTAGRAM mark are attached hereto as Exhibit A, and are incorporated by reference as though fully set forth herein.

3. In addition, Instagram owns common law rights in the INSTAGRAM mark in connection with various other goods and services, including as identified in pending U.S. trademark applications. All of Instagram's marks that feature the term INSTAGRAM are referred to herein as the "INSTAGRAM Marks."

4. The INSTAGRAM mark is highly distinctive with regard to photo and video sharing services and software, and social networking services. Moreover, through Instagram's widespread use of the INSTAGRAM Marks, extensive and continuous media coverage, the high degree of consumer recognition of the INSTAGRAM Marks, Instagram's enormous and loyal

user base, its multiple trademark registrations and pending applications, and other factors, the INSTAGRAM Marks have become famous within the meaning of Section 43(c) of the United States Trademark Act, 15 U.S.C. § 1125(c).

5. On August 13, 2013, Applicant filed an application to register the INSTABANG Mark for: “[i]nternet based social networking, introduction, and dating services” and “[w]eb site services featuring on-line dating club,” both in International Class 45, alleging a first use date of July 1, 2013.

6. Upon information and belief, Applicant has used and is using the INSTABANG Mark in connection with a website and online service that facilitates sexual encounters and contains pornographic and sexually-explicit material.

7. Upon information and belief, the term “bang” is a slang term for sexual intercourse and invokes a vulgar meaning to a substantial composite of the general public.

8. Applicant’s Mark was published in the *Official Gazette* on January 7, 2014.

**FIRST GROUND FOR OPPOSITION:
LIKELIHOOD OF CONFUSION**

9. Instagram incorporates by reference Paragraphs 1 through 8, inclusive, as if fully set forth herein.

10. Instagram began using its INSTAGRAM mark at least as early as October 2010, and filed applications resulting in federal registrations prior to Applicant’s application to register the INSTABANG Mark or, on information and belief, any actual use by Applicant of Applicant’s Mark.

11. The INSTAGRAM Marks are inherently strong and have become famous.

12. Applicant’s Mark, particularly as identified in its application, is likely to cause confusion, or to suggest an association between Applicant and Instagram, where none exists.

13. Instagram is not affiliated or connected with Applicant or its services; nor has Instagram endorsed or sponsored Applicant or its services.

14. Registration of Applicant's Mark will damage Instagram because Applicant's Mark is likely, when used on or in connection with the services described in the opposed application, to cause confusion, or to cause mistake or to deceive. Thus, Applicant's Mark is unregistrable under 15 U.S.C. §§ 1052, 1053, 1063 and 1125 and should be refused registration.

**SECOND GROUND FOR OPPOSITION:
DILUTION OF A FAMOUS MARK**

15. Instagram incorporates by reference Paragraphs 1 through 14 inclusive, as if fully set forth herein.

16. The INSTAGRAM Marks are inherently distinctive.

17. Instagram has used the INSTAGRAM trademark since at least as early as 2010 for photo sharing and social networking goods and services, and has expanded use of the INSTAGRAM Marks to many other goods and services.

18. Instagram is the owner of multiple U.S. registrations and applications for the INSTAGRAM Marks.

19. Instagram has continuously used the INSTAGRAM Marks throughout the United States and internationally.

20. As a result of the enormous publicity afforded the INSTAGRAM Marks, and the strong and loyal base of customers that enjoys Instagram's goods and services, the INSTAGRAM Marks have a high degree of consumer recognition, are widely recognized by the general consuming public of the United States as a designation of Instagram's goods and services, and are famous.

21. The INSTAGRAM Marks became famous before Applicant filed to register the

INSTABANG Mark on August 13, 2013 or, on information and belief, any actual use by Applicant of Applicant's Mark.

22. Applicant's Mark is likely to cause an association between Applicant's Mark and the INSTAGRAM Marks. This false association impairs the distinctiveness of the INSTAGRAM Marks and weakens the connection in the public's mind between the INSTAGRAM Marks and Instagram's goods and services.

23. Applicant's Mark is likely to cause dilution by blurring.

24. In addition, Applicant's use of the INSTABANG Mark for online adult dating and social networking services that provides a platform to users to connect with others for sexual encounters tarnishes the famous INSTAGRAM Marks and harms the reputation of the INSTAGRAM Marks to Instagram's detriment.

**THIRD GROUND FOR OPPOSITION:
SCANDALOUS MATTER**

25. Instagram incorporates by reference Paragraphs 1 through 24 inclusive, as if fully set forth herein.

26. The INSTABANG Mark references sexual intercourse. The term "BANG" in "INSTABANG" is a slang term for sexual intercourse. The term "INSTA" in Applicant's Mark does not mitigate the vulgarity of the term "BANG."

27. Upon information and belief, the INSTABANG Mark is considered vulgar by a substantial composite of the general public in the context of contemporary attitudes when used in connection with the services described in Applicant's application for the mark.

28. Applicant's Mark is thus scandalous within the meaning of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and should be refused registration.

Wherefore, Instagram prays that this Opposition be sustained, and that Application Serial

No. 86/036,656 be refused.

Respectfully submitted,

COOLEY LLP

Date: August 15, 2014

By: Brendan J. Hughes/

Peter J. Willsey

Brendan J. Hughes

Rebecca Givner-Forbes

1299 Pennsylvania Avenue, NW, Suite 700

Washington, D.C. 20004

Tel : 202-842-7800

Fax: 202-842-7899

Email: pwillsey@cooley.com

bhughes@cooley.com

rgivnerforbes@cooley.com

Attorneys for Opposer Instagram, LLC

CERTIFICATE OF TRANSMITTAL AND SERVICE

I hereby certify that this Notice of Opposition is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below.

I hereby further certify that on the date indicated below, a true and correct copy of this Notice of Opposition was placed in the United States Mail via First Class Mail, addressed to Applicant's counsel as follows:

Jason A. Fischer
Randazza Legal Group
2 S. Biscayne Blvd., Suite 2600
Miami, Florida 33131

Date: August 15, 2014

/Aaron M. Fennimore/
Aaron M. Fennimore
1299 Pennsylvania Avenue, NW, Suite 700
Washington, D.C. 20004
Tel : 202-842-7800
Fax: 202-842-7899
Email: afennimore@cooley.com

Attorney for Opposer Instagram, LLC

109519400